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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,579	09/30/2003	Carl D. Neuburger	081069-0305991	1611
909	7590	06/29/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			ZIRKER, DANIEL R	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			1771	
DATE MAILED: 06/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/673,579	Applicant(s) NEUBURGER, CARL D.	
	Examiner Daniel Zirker	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
4a) Of the above claim(s) 17-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/30/03</u> . | 6) <input type="checkbox"/> Other: ____ |

Handwritten initials

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1. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-16, drawn to an adhesive transfer device having a core for selectively making a repositionably adherable substrate from a selected substrate, classified in Class 156, subclass 234.

II. Claims 17-30, drawn to an adhesive transfer device to be used in conjunction with an adhesive transfer apparatus comprising a frame and a pair of cooperating structures mounted to the frame for selectively making a repositionably adherable substrate from a selected substrate, classified in Class 156, subclass 230.

2. III. Claims 31-52, drawn to an adhesive transfer device for selectively making a repositionably adherable substrate from a selected substrate, classified in Class 428, subclass 40.1.

3. The inventions are distinct, each from the other because of the following reasons:

4. Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions each relate to adhesive

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articles being adhered to substantially different structural devices and as such are seen to be separate and distinct inventions not further related for purposes of restriction.

5. Inventions Group III and Group I are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive bearing article having a wide variety of adhesive related usages in multiple fields of use and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. Inventions Group III and Group II are related as mutually exclusive species in an intermediate-final product

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relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as an adhesive article having a wide variety of bonding usages and a variety of adhesive related applications and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

7. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classifications, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Bryan Collins on June 10, 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-16. Affirmation of

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this election must be made by applicant in replying to this Office action. Claims 17-52 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

10. The drawings are objected to because they contain quite a significant number of informalities, of which the Examiner will attempt to point out those relevant to the elected claims, however, others may be missed. It is first noted that the selected substrate or master 26 is missing from Figures 16, 1 and 2 which appear to be the most relevant Figures for the claimed invention, and it is also noted that element 30 is not in Figure 6, as stated in the specification. Additionally, it appears proper from the disclosure in both paragraph No. 0058 and in other places in the specification to be necessary to set forth a suitable description of the believed cylindrical core in Figure 10 since the element appears in the claims (e.g. claim 1 line 3)

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and only apparent relevant disclosure of this element appears to be a very brief sketch which applicants' can be seen in applicants' last Figure, Figure 16. It also appears that Figure 10 is non-enabling in its present form and Figure 16, which discloses the embodiment closest to the embodiments set forth in applicants' elected claims 1-16 is found difficult to understand, e.g. the base substrate 208 is not exemplified at all in the Figure, it is further noted that Figure 16 has three different elements each labeled as element 204 (note paragraph No. 0069), and the core surface does not appear to face generally radially outward, but rather circumferentially outward, i.e. note paragraph 0070. Finally, as has been noted, it is believed that other errors may well exist and applicants are urged to correct them.

11. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

12. Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, quite a few

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informalities exist particularly in claim 1 and the Examiner will attempt to point them out, although others may exist and applicants should be prepared to make the appropriate corrections. In claim 1, line 2 "selected substrate" is nowhere defined, which is also the case for "core" in line 3 and as such these two essential elements are clearly vague and indefinite as the claim now exists. In lines 4-5 the Examiner suggests that the "release surface" should be noted as being present on an opposing outer surface to said adhesive carrying surface rather than just being characterized as "opposite". In line 8 the phrase "adjacent to" should be changed so as to reflect the structure set forth in the last two lines of page 6 of the specification which indicate that the entire repositionable adhesive layer is covered by the permanent adhesive layer. Additionally, "opposite" is again vague and indefinite. Finally, with respect to claim 1, the Examiner notes that in lines 10-13 applicants state that the release surface faces in a generally radial direction with respect to the core and the adhesive layers face in a generally radial direction with respect to the core opposite the first generally radial direction which the Examiner believes conflicts with his earlier discussion regarding the circumferential or tangential location of the surfaces and also with the disclosure of applicants' dependent claim 12.

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Clarification is requested. Finally, in claim 2, line 3 and elsewhere "frame" is also believed to be vague and indefinite for the same general reasons that "core" and "selected substrate" are.

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 1-16 are rejected under applicants' admissions in the specification at page 19, lines 18-19 taken in view of Sasaki et al '913. Applicants appear to admit that the general construction of the adhesive transfer device claimed is well known except for the presence of the claimed multi-layer adhesive laminate set forth in lines 4-9 of claim 1. Although methods for

the formation of an adherable substrate through the use of an adhesive layer applied to the substrate are also known in the art the prior art has generally failed to teach or suggest the utilization of an adhesive film assembly which comprises in order, a releasable base substrate, a layer of repositionable adhesive on the base substrate, a layer of permanent adhesive on the repositionable adhesive and a release film on the permanent adhesive layer. However, Sasaki et al. US 5,558,913 teaches a laminate of a backing, a layer of permanent pressure sensitive adhesive and a layer of removable pressure sensitive adhesive, the latter being in contact with the release surface of a release liner of the opposed surface of the backing. The permanent adhesive layer bonds the removable layer to the backing, thereby allowing the backing to be removably adhered to a contact surface. While Sasaki et al is primarily concerned with pre-made labels and stickers of predetermined size such as mailing labels and the like, by itself it cannot be used to make pre-existing non adherable substrates such as photographs and signs. One of ordinary skill, however, motivated by the desire to create repositionably adherable substrates of different types and sizes for a variety of applications would apply the adhesive construction of Sasaki et al onto the adhesive transfer device admitted as known by applicants and operate the resulting

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structure in the manner set forth by applicants to thereby form the claimed genus of devices. With respect to the dependent claims these, if not expressly or inherently disclosed by the claimed combination are each believed to be obvious modifications to one of ordinary skill, in the absence of unexpected results.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**DANIEL ZIRKER
PRIMARY EXAMINER**

Daniel Zinker

Dzirker:cdc

June 15, 2005